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EXAMINER
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BARBEE, MANUEL L

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KEE-HUNG LAI,  
WAI-TING NGAI AND EDWIN TAI-CHIU CHENG

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Appeal 2007-3021  
Application 10/690,821<sup>1</sup>  
Technology Center 2800

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Decided: May 8, 2008

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Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and  
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed October 23, 2003. The real party in interest is Hong Kong Polytechnic University.

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-9, 11, and 12, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

#### STATEMENT OF THE CASE

Appellants' invention relates to an evaluation instrument for evaluating supply chain performance in the field of transport logistics. (Spec. 1:5-8.)

Claim 1 is exemplary:

1. An instrument for evaluating supply chain performance in transport logistics including a plurality of measurement items wherein said items are divided into at least the dimension of service effectiveness for shippers, service effectiveness for consignees and operations efficiency for transport logistics providers, wherein said plurality of measured items in the dimension of service effectiveness to shippers include:

fulfilling promises to shippers;

solving shippers' problem;

performing services for shippers right the first time;

providing services at the time promised to the shippers;

keeping shippers' records accurately;  
informing shippers exactly when services  
will be performed;

giving prompt services to shippers;

willingness to help shippers; and

timely response to shippers' requests.

Claims 1-9, 11, and 12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, first paragraph. The issue turns on whether the originally filed Specification contains a teaching of the manner of making and using the claimed instrument for evaluating supply chain performance in transport logistics without undue experimentation.

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants describe an instrument for evaluating supply chain performance (SCP) in transport logistics. (Spec. 3:11-12.) The instrument includes "a plurality of measurement items wherein said items are divided into at least the dimension of service effectiveness for shippers [SES], service effectiveness for consignees [SEC] and operations efficiency [OE] for transport logistics providers." (Spec. 3:12-15.) "This invention provides users with a comprehensive list of 26 items for measuring SCP in transport logistics, which can be used to evaluate the status of their SCP so as to uncover improvement areas." (Spec. 15:8-10.)
2. According to the Specification, "Figure 2 shows a measurement instrument in accordance with an embodiment of the invention." (Spec. 4:17-18.) In particular, "[a] total of 26 measurement items may . . . be generated for the measurement instrument: nine for SES, eight for OE and nine for SEC as shown in Figure 2." (Spec. 8:13-14.)
3. The Specification teaches that,  

[a]t the individual item and sub-dimension levels, a user may look at the performance for each

individual item and sub-dimension and may identify areas in need of special attention. For instance, if a service provider underperforms in the SES-REL item "fulfill promises to shippers", this would signal a need for improvement actions for that particular item. On the other hand, an analysis of the construct at a higher level of abstraction offers several advantages. It may reveal patterns not readily revealed by studying individual items and sub-dimensions only."

(Spec. 14:10-16.)

#### PRINCIPLES OF LAW

On appeal, all timely filed evidence and properly presented arguments are considered by the Board. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred.

The first paragraph of 35 U.S.C. § 112 requires, among other things, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without "undue experimentation." *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Whether undue experimentation is required is a conclusion reached by weighing several underlying factual inquiries. *Id.* at 736.

A specification need not disclose what is well known in the art. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). However, this is merely a rule of supplementation, not a substitute for a basic enabling disclosure. *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. *Id.* It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. *Id.*

#### ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-9, 11, and 12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Reviewing the record and the findings of facts cited above, we agree.

Regarding independent claim 1, the Examiner found that the "[s]tructure of the instrument for evaluating supply chain performance is not enabled by the disclosure." (Ans. 3.) In particular, the Examiner found that one of ordinary skill would be reduced to trial and error because "[t]he specification does not disclose any specific way to measure the measurement items. Only a questionnaire is disclosed." (Ans. 4-5.)

Appellants argue that the 26 measured items disclosed by the Specification are descriptive and a person of ordinary skill in the art would have been able to use the responses to each of the items in order to evaluate supply chain performance. (App. Br. 4; Reply Br. 4.) Appellants also argue that the questionnaire is an enabling mechanism that allows users to evaluate supply chain performance in the context of transport logistics. (App. Br. 5; Reply Br. 5-7.) We agree.

The Specification teaches that the instrument (questionnaire) includes 26 items for evaluating supply chain performance in transport logistics. (FF 1-2.) In addition, the Specification teaches that each item may be used to identify areas in need of attention and the need for improvement action to be taken for that item. (FF 3.) We find that this disclosure would enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation.

Accordingly, we conclude that Appellants have shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, first paragraph. Claims 2-4, 6-9, and 12 depend from claim 1, and we reverse the rejection of these claims for the reasons discussed with respect to claim 1. Independent



claims 5 and 11 recite limitations similar to claim 1, and we reverse the rejection of claims 5 and 11 for the reasons discussed with respect to claim 1.

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

*35 U.S.C. § 102(b)*

Claims 1-9, 11, and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Applicants' original paper in *Transportation Research Part E*, Vol. 38, 2002, pp. 439-456" (Reply Br. 5) ("the *Transportation Research Part E* paper").<sup>2</sup> The *Transportation Research Part E* paper was available online April 25, 2002, which is more than one year prior to the critical date of October 23, 2003.<sup>3</sup>

Appellants admit (Reply Br. 5-6) that the *Transportation Research Part E* paper discloses the claimed invention. Because it was available online more than one year prior to the critical date, claims 1-9, 11, and 12 are anticipated under 35 U.S.C. § 102(b) by the *Transportation Research Part E* paper.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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<sup>2</sup> We note that Appellants reference this document for the first time in the Reply Brief, but did not identify the document or provide a copy in the Evidence Appendix.

<sup>3</sup> There is no claim of priority to an earlier-filed application.

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that:

- (1) Appellants have shown that the Examiner erred in rejecting claims 1-9, 11, and 12 under 35 U.S.C. § 112, first paragraph, for failure to comply with the enablement requirement.
- (2) Claims 1-9, 11, and 12 are unpatentable under 35 U.S.C. § 102(b).

#### DECISION

The rejection of claims 1-9, 11, and 12 under 35 U.S.C. § 112, first paragraph, for failure to comply with the enablement requirement is reversed.

Claims 1-9, 11, and 12 are rejected as being anticipated under 35 U.S.C. § 102(b).

Appeal 2007-3021  
Application 10/690,821

New grounds of rejection have been entered under 37 C.F.R.  
§ 41.50(b).

No time period for taking any subsequent action in connection with  
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED  
37 C.F.R. § 41.50(b)

Appeal 2007-3021  
Application 10/690,821

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